

Claim Rejections

In the current Office Action, the Examiner repeats the rejections previously presented in the final Office Action of January 26, 2005:

- claims 1-3, 8, 9, 11, and 12 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Zigmond et al., U.S. Patent No. 6,698,020 (“Zigmond”);
 - claim 4 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Zigmond, in view of Hendricks et al., U.S. Patent No. 6,408,437 (“Hendricks”);
 - claim 10 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Zigmond, in view of Rakavy et al., U.S. Patent No. 6,317,789 (“Rakavy”); and
 - claim 13 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Zigmond, in view of Seth-Smith et al., U.S. Patent No. 4,866,770 (“Seth-Smith”).

Claims 1, 9, 11, and 12

Regarding independent Claims 1, 9, 11, and 12, Applicant submits that Zigmond fails to disclose or suggest at least assigning an evaluation value to received, stored advertisement data, as claimed, based on a reproduction time, a reproduction position, and a preference of a user. Applicants submit that Claims 1, 9, 11, and 12 are patentable for at least those reasons set forth in the 1.116 Amendment of April 26, 2005, as further discussed below.

In response to Applicants’ argument, as previously presented in the April 26 Amendment, the Examiner asserts that Zigmond’s description of “pre-screening” ads with an ad filter discloses the claimed limitation of assigning an evaluation value to received, stored advertisement data. The Examiner asserts that the ad filter, which uses selection criteria to select ads which are to be stored discloses the limitation.

As noted in the April 26 Amendment, Claims 1, 9, 11, and 12 each recite two distinct limitations. First, selection standards are set and received advertisement data which meets the selection standards is stored. Second, evaluation values are assigned to the *stored* advertisement

data. These are two separate limitations. However, the Examiner relies on a single description in Zigmond to disclose both of these distinct limitations. While Applicants note that a single element in a prior art reference *may* properly disclose two separate limitations in a claim, this is not the case in this instance.

Independent claims 1, 9, 11, and 12 each clearly recite that an evaluation value is assigned to *the stored advertisement data*, which clearly refers to the advertisement data which is stored in accordance with the selection and storage of advertisement data which meets selection standards, of the first distinct limitation. Even if Applicants were to assume, *arguendo* that the function of the ad filter in Zigmond discloses assigning an evaluation value, there is no teaching or suggestion that the ad filter acts on *stored advertisement data*. In fact, it is clearly described in Zigmond that the function of the ad filter is to determine those ads which are *to be* stored.

Therefore, in view of the above, Applicants submit that Zigmond fails to anticipate Claims 1, 8, 11, and 12, and respectfully request that the rejection of these claims be reconsidered and withdrawn.

Claims 2-3

In view of the above, Applicants submit that Claims 2 and 3 are patentable at least by virtue of their dependence on Claim 1 and respectfully request that the rejection of Claims 2 and 3 be reconsidered and withdrawn.

Claims 4, 8, 10, and 13

Applicants submit that Hendricks, Rakavy, and Seth-Smith all fail to remedy the above-discussed deficiencies in Zigmond and, therefore, Claims 4, 8, 10, and 13 are patentable at least

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/699,554

Q61559

by virtue of their dependence on Claims 1 and 9. Applicants respectfully request that the rejection of Claims 4, 8, 10, and 13 be reconsidered and withdrawn.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Laura Moskowitz
Registration No. 55,470

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: December 21, 2005